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Req. for  
Rehearing  
3/24/05  
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81749AJA  
Appeal No. 2004-2011  
Customer No. 01333

**In the United States Patent and Trademark Office**  
**Board of Patent Appeals and Interferences**

In re Application of:

Ward B. Bowen, Jr., et al

Photographic Element With Light  
Sensitive Layer Comprising Blend Of  
High Chloride Emulsions Grains Doped  
With Different Metal Complexes

Serial No. 09/919,239

Filed 31 July 2001

Board Of Patent Appeals And Interferences  
United States Patent And Trademark Office  
P.O. Box 1450  
Alexandria, VA 22313-1450

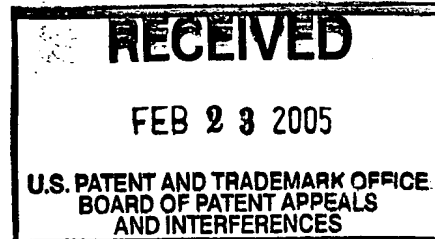
Sir:

Group Art Unit: 1752

Examiner: Amanda C. Walke

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*Valerie J. Richardson*  
Valerie J. Richardson  
*February 15, 2005*  
Date



**REQUEST FOR REHEARING TRANSMITTAL**

Enclosed herewith is Appellants' Request for Rehearing for the above-identified application.

The Assistant Commissioner is hereby authorized to charge any required fee associated with this request to Deposit Account 05-0225. A duplicate copy of this letter is enclosed.

Respectfully submitted,

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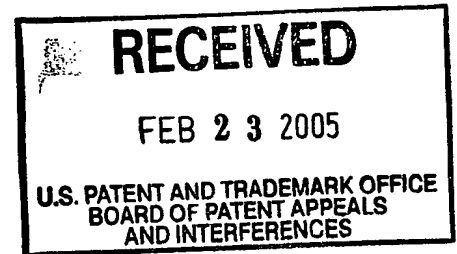
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Date



**REQUEST FOR REHEARING PURSUANT TO 37 C.F.R. 41.52**

In response to the Decision on Appeal mailed December 15, 2004,  
Appellants hereby request rehearing to consider the following points believed to  
have been misapprehended or overlooked by the Board.

As essentially noted at page 5 of the Decision, it is Appellants'  
principal contention that co-doping of grains of an emulsion with dopants of formulae  
(I) and (II) in accordance with prior art teachings results in a latent image keeping  
(LIK) problem, and that there is no teaching or suggestion in the prior art to employ  
such dopants independently in separate grain fractions of an emulsion in order to  
address such problem.

A first point misapprehended or overlooked by the Board is that contrary to the assertion at page 6, lines 2-4 of the Decision, Makuta does not cite Newmiller for disclosing the types of mixed grain emulsions “that can be used in the silver chloride photographic emulsions of Makuta”. Rather, as explained in Appellants’ Brief (page 4, lines 22+), Makuta discloses a variety of grain halide compositions applicable in the invention thereof. This is clearly described at col. 62, lines 31+ of Makuta, where, e.g., silver bromide and silver iodobromide grains are specifically disclosed as being applicable to the invention in addition to silver chloride grains. Note further that neither the Examiner nor the Board has addressed Appellants’ point (see Appellants’ Brief, page 4, line 31 – page 5, line 4) that contrary to the Examiner’s statements that the blended emulsions of Newmiller are only “preferred” to be directed to silver bromide or iodobromide grains, the invention described in Newmiller et al is in fact limited thereto. Thus, as Makuta is disclosed as broadly applicable to all forms of silver halide emulsions and as Newmiller is specifically directed only towards silver bromide or silver iodobromide emulsions, rather than cite Newmiller “for disclosing the types of mixed grain emulsions that can be used in the silver chloride photographic emulsions” thereof, the reasonable interpretation of what might have been *prima facie* contemplated by Makuta’s reference to Newmiller would be that the mixed grain silver bromide or silveriodobromide emulsions as taught by Newmiller may be used in the invention of Makuta. As stated at page 5, lines 4-7, and as yet not addressed by the Board, based on this point alone, the proposed combination of Makuta et al in view of and Newmiller et al is not pertinent to the present claimed invention directed specifically towards mixing differentially doped grains in high chloride emulsions, and clearly is only suggested in hindsight based on Applicant’s teachings. It is further noted that even if one were to argue that Makuta’s citing of Newmiller might be more generally applicable (even though there is no basis for such suggestion based on the actual disclosures of either Makuta or Newmiller themselves), there is in any event no explanation as to how the suggested blending of emulsions of different tabularity as actually suggested by Newmiller would necessarily result in a blended emulsion still meeting the {100} crystal faces surface area limitations of the present claims, especially as the tabular silver bromide and silver iodobromide high aspect ratio emulsion technologies referenced by Newmiller (col. 2, lines 57+) are directed

primarily towards tabular emulsions with {111} main crystal faces. This is further evidence that the proposed rejection is obtained only through the impermissible use of hindsight based on Appellants' teachings.

A second point misunderstood or overlooked by the Board is that neither the Examiner nor the Board has provided any explanation as to motivation found in the cited art to dope separate fractions of emulsion grains individually specifically with the dopants of the Keevert and McDugle references. As explained in Appellants' Brief (page 6, lines 17+), the mere possibility that individual teachings of the prior art could be combined to arrive at the claimed invention does not equate to establishing that it would have been obvious to the artisan to do so. To the extent the Board may be relying upon the Examiner's contentions that one skilled in the art "would have been motivated to combine an additive that provided high contrast but also decreased the speed (sensitivity) with an additive that would increase the speed to even out the sensitivity" as stated at page 5, lines 14-16 of the Examiner's Answer, this still provides no explanation as to why one would differentially employ such dopants in separate grain fractions, rather than employ such dopants equally in all grain fractions when used together as has actually been employed in the prior art as noted by Appellants. It is only Appellants' teaching of improved LIK which provides the motivation to differentially dope separate fractions specifically with dopants of formulae (I) and (II) in accordance with the claimed invention, not any teaching or suggestion in the cited prior art.

A third point misunderstood or overlooked by the Board is that the Board agrees with the Examiner's statement that "the presently claimed emulsion may actually comprise two fractions having virtually the same grains, thus only one type of grain and not two distinct fractions." Such statement is simply not correct. All claim limitations must of course be considered. The claims specifically require two distinct grain fractions, with non-overlapping dopant concentrations. As claim 1 sets forth two specific distinct relative dopant concentration requirements; the grains are not "virtually" the same, but in stark contrast are specifically differentiated. Noting that they may come "close" at the outer limits of the claimed ranges ignores that fact that the prior art still does not suggest even such close differential doping. The specific requirements distinguish the present invention from the prior art by requiring the two specified dopants be employed primarily in separate grain fractions, which as

demonstrated in the examples provided in the present specification results in the benefit of improved LIK relative to the prior art. To ignore such specific differential doping claim limitation simply as being "close" is of course improper when evaluating whether providing such a distinction would have been suggested by the teachings of the prior art.

A fourth point misunderstood or overlooked by the Board is that the Board states that Appellants' arguments are not commensurate in scope with the degree of protection sought due to the possibility of such close dopant concentration ranges as discussed above. Appellants respectfully disagree. Appellants' arguments are based on the fact that the prior art does not teach differential doping of the specific dopants in separate grain fractions, while the claims specifically require such differential doping. It is believed the arguments and the claims are accordingly entirely commensurate in scope. The claims are drafted to correspond to the invention as broadly as is enabled while not reading on the prior art. The prior art provides no motivation to provide any differential doping for the specified dopants in separate grain fractions, and Appellants should be able to claim the invention as broadly as allowed by the prior art consistent with Appellants' teachings.

A fifth point misunderstood or overlooked by the Board is that the Board states that Appellants' base no argument upon objective evidence of nonobviousness, such as unexpected results, which would serve to rebut a *prima facie* case of obviousness established by the Examiner. While it is Appellants' primary position that the Examiner has failed to establish a *prima facie* case of obviousness in view of the deficiencies of the teaching of the cited art as to providing any motivation to employ the specified dopants at mutually exclusive different concentrations in separate grain fractions of an emulsion in accordance with the present claims, Appellants have also pointed out that by differentially doping separate grain fractions, the present invention surprisingly enables the use of a desired combination of contrast and speed improving dopants with improved latent image keeping performance (see, e.g., Appellants' Brief, page 4, lines 1-17). The photographic examples of the application itself clearly support such statement, as they demonstrate that when such differential doping is actually practiced, improved LIK performance is obtained relative to employing such dopants in uniformly co-doped grains, as is actually practiced in the prior art (see, e.g., significantly lower Optical and Laser LIK data

values in Tables I and II for emulsions D and E comprising differentially doped fractions in accordance with the invention compared to emulsion C comprising a single type of uniformly co-doped grains). Such improved LIK is not suggested by the prior art, and is further evidence of the non-obviousness of the present claimed invention.

In conclusion, it is only Appellants' teaching with respect to improved latent image keeping results that provides the motivation to independently differentially dope separate grain fractions in accordance with the claimed invention. The Examiner and the Board's Decision misinterpret the teachings of the prior art improperly and rely upon only portions thereof taken out of context, which are combined in an attempt to arrive at the presently claimed invention without providing any motivation to do so. Reconsideration and reversal of this rejection upon rehearing is accordingly respectfully requested.

Respectfully submitted,



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